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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,356	09/11/2001	Manthias Witschel	49828	4151

7590 CA/04/2003
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EXAMINER

ANDERSON, REBECCA L.

ART UNIT PAPER NUMBER

1626

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,356

Applicant(s)

WITSCHER ET AL.

Examiner

Rebecca L Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 12, 14-16 and 22-23 is/are rejected.
- 7) ☒ Claim(s) 1-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other.

Art Unit: 1626

DETAILED ACTION

Claims 1-16 and 18-23 are currently pending in the instant application. Claims 18-21 are withdrawn from further consideration as being to a non-elected invention. Claims 1-16 and 22-23 are objected to for containing non-elected subject matter.

Election/Restrictions

With the Examiner's invitation to identify a group outside of the groups identified by the Examiner, applicant's election with traverse of the new group represented by claim 22:

Wherein: **R1, R2, R3, I, R4 and R5** are as found in claim 1,

X is a bond,

Y together with the two carbons to which it is attached forms a 1,2-

isoxazole ring which is saturated, partially saturated or unsaturated; and

R9 is a radical IIa

in Paper No. 6 is acknowledged. The traversal is on the ground(s) that under PCT Rule 13, the unity of invention requirement is met when "one or more of the same or corresponding special technical features" are involved in the technical relationship between inventions which are claimed in the international application and that the special technical features of a claimed invention are those which define the contribution which each of the inventions, considered as a whole, makes over the prior art.

Applicant also states that there are three special technical features, which define the contribution over the prior art. However, this is not found persuasive because although applicant asserts that there are three special technical features, the technical feature

Art Unit: 1626

involved in the claimed inventions is the tricyclic compound characterized in that the respective benzoyl unit is fused with a bicycle, which does not define a contribution over the prior art (as seen by WO 97/19087 and EP-A 860 441). The substituents on the tricyclic compound and the bicycle itself vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a burden on any examination of the claimed subject matter.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

Claim 5 is objected to because of the following informalities: the German term "oder" should be replaced with the English term "or". Appropriate correction is required. Claims 1-16 and are objected to as containing non-elected subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 12, 14-16 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/19087 (TSENG et al.).

Art Unit: 1626

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

The elected invention of the instant application claims tricyclic benzoylpyrazole compounds of the formula I wherein X is a bond, Y together with the two carbons to which it is attached forms a saturated, partially saturated or unsaturated 1,2-oxazole ring and R9 is the radical IIa (claim 1-4 and 22) wherein R1 and R2 can be hydrogen, R3 can be C1-C6 alkyl, R4 can be C1-C6 alkyl, R5 can be hydrogen and I can be 0 or 1 (claim 5) and wherein R10 can be hydroxyl, R11 can be C1-C6 alkyl and R12 can be hydrogen (claim 6 and 23). The instant application also claims a herbicidal composition of the compound as found in claim 1 (claim 14), its method of preparation (claim 15) and a method for controlling undesirable vegetation with the compound as found in claim 1 (claim 16). Processes for the preparation of the compounds of formula I as found in claim 1 by reaction with the compound of formula III wherein L1 is a nucleophilically replaceable leaving group are claimed in claim 8 and processes for the preparation of the compounds of formula I as found in claim 1 by reaction of a pyrazole of formula VII with an activated tricyclic benzoic acid of formula VI β are claimed in claim 12.

Determining the scope and contents of the prior art

TSANG et al. discloses the herbicidal active (page 141, lines 25-26) compounds of the formula I as found on page 1, line 20 wherein Q can be Q-2 (page 1, lines 20-25

Art Unit: 1626

and is also preferred to be Q-2 (page 12, line 20, preference 5), J is as found on page 2, lines 1-5, m is 0, 1 or 2, n is 1 or 2 and p is 0, 1, or 2 (page 4, lines 5-10). Preferences towards the compound wherein Y together with the two carbons to which it is attached forms an unsaturated 1,2-oxazole ring is found on page 7 (compound J-9) wherein R¹⁸ can be hydrogen, C1-C6 alkyl, C1-C6 haloalkyl, etc. (page 11). Preferences towards compounds wherein X is CH₂ is found on page 161 in the Index Table C (compound #25). Preferences towards compounds wherein R₁ and R₂ can be H and C1-C3 alkyl, etc., R₇ is H or C1-C6 alkyl and R₈ is hydrogen (page 12, preference 6). Preferences for R₆, when Q is Q-2, as OR₁₄ and OH is found on page 23, lines 14-22, scheme 17. Herbicidal formulations of the compounds and methods of preparing are found on page 139, lines 1-20 and page 165, Test A. Page 141 discloses the method for controlling undesirable vegetation, lines 25-40. Page 23 discloses scheme 17 which is a method for the preparation of compounds of the formula 1e, wherein Q is Q-2 by reaction with a compound of the formula 18 wherein X₂ is chlorine and R₁₄ can be H, C1-C6 alkyl, C1-C6 haloalkyl, etc. (page 3, line 35). Page 24 discloses scheme 19 wherein a compound of the formula 5, an activated tricyclid benzoid acid (page 16, lines 5-10) is reacted with the compound of formula 20, a pyrazole compound.

Ascertaining the differences between the prior art and the claims at issue

The difference between the prior art and the claims at issue is that the prior art generically encompasses and provides preferences towards positional isomers (i.e. the

Art Unit: 1626

carbonyl moiety is in the para position in regards to X instead of the ortho position) of the instantly claimed compounds.

Resolving the level of ordinary skill in the pertinent art

However, minus a showing of unobvious results, it would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds, with the instantly claimed methods of claims 8 and 12 for use as herbicidal formulations when faced with the prior art of TSANG et al. which discloses the compound of formula I which generically encompasses positional isomers of the instantly claimed compounds and provides preferences towards positional isomers of the instantly claimed compounds and provides schemes 17 and 19 which disclose methods of preparation for these compounds which have the discloses use as herbicidal formulation. The motivation would be that it is expected that the further production of compounds similar in structure would have similar herbicidal properties, that the prior art provides preferences towards positional isomers of the instantly claimed compounds and that nothing unobvious is seen in substituting the known claimed isomer for the structurally similar isomer, as taught by TSANG et al., since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results. In re Norris, 84 USPQ 458 (1950).

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703)

Art Unit: 1626

605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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